

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of)	Examiner: n/a
)	
Brzustowicz, L.M. et al.)	Art Unit: n/a
)	
Serial No.: PCT/US01/13107)	
)	
Filed: April 23, 2001)	
)	
For: "METHODS AND COMPOSITIONS)		
FOR THE DIAGNOSIS OF)	
SCHIZOPHRENIA)	

SECOND RENEWED PETITION FOR REVIVAL OF AN INTERNATIONAL
APPLICATION FOR PATENT DESIGNATING THE U.S. ABANDONED
UNINTENTIONALLY UNDER 37 CFR 1.137(B)

Dear Sir:

The above-identified PCT application, having Serial No. PCT/US01/13107 (hereafter the '13107 application), became abandoned for failure to file the national stage requirements (35 U.S.C. 371(c)) at the U.S. Patent and Trademark Office. Applicants submit that the failure to file the national stage requirements was unintentional and until recently, it was the belief of the undersigned that the Application could not be revived. The undersigned was recently made aware of certain facts associated with this abandonment and now respectfully requests that the Application be revived for the reasons set forth herein below. A Second Declaration from Dr. Anne S. Bassett is attached hereto. Previously submitted Declarations of Mr. Vincent Smeraglia and Drs. Brzustowicz and Bassett are also provided herewith in support of the present petition.

The '13107 application was filed on April 23, 2001 and claims priority to U.S. provisional application Serial No. 60/198/987 which was filed on April 21, 2000. At the time the

'13107 Application was filed, Rutgers, the State University of New Jersey (herein after "Rutgers") had also caused an additional 17 PCT applications to be filed directed to similar subject matter. Each of these PCT applications named Drs. Linda M. Brzustowicz and Anne S. Bassett as co-inventors.

As evidenced by the previous declaration of Drs. Brzustowicz and Bassett and copies of email communications between Dr. Brzustowicz and Mr. Vincent A. Smeraglia, Associate Director at the Office of Corporate Liaison and Technology Transfer, Rutgers, The State University, which are submitted herewith, within the last year, Drs. Brzustowicz and Bassett became aware that Rutgers had failed to file the national stage requirements for the '13107 application by December 21, 2001 thereby resulting in abandonment of the US National phase application. Dr. Brzustowicz became aware of the abandonment in January 2005 whereas Dr. Bassett was not informed of the abandonment until sometime in November of 2005.

Drs. Brzustowicz and Bassett had no intention whatsoever of abandoning the application as set forth in their Declaration attached hereto. The inventors were of the belief that the filing requirements had been met and that everything was in order with the filing.

As stated in the Declaration of Mr. Vincent Smeraglia, then an employee of Rutgers tech transfer office, in November of 2002, the undersigned was contacted and provided instructions to allow all Brzustowicz applications to lapse. These instructions were in error as it was the intention of the office and the named co-inventors to pursue the '13107 application directed to an alternative splice variant of the CAPON gene associated with schizophrenia. In addition, these instructions were given to the undersigned without communication to Drs. Brzustowicz and Bassett. This miscommunication is evidenced by copies of emails

exchanged between Dr. Brzustowicz and Mr. Smeraglia attached hereto. In November of 2005, the undersigned was made aware that Dr. Bassett had no knowledge of the abandonment of the application and moreover had been led to believe the application was pending before the USPTO. Dr. Brzustowicz, as an employee of Rutgers University, was under an obligation to assign her rights in the invention to Rutgers. However, Dr. Anne Bassett was under no such obligation as she is not employed by Rutgers nor did any agreement exist requiring her to assign her rights in the invention to Rutgers. She is a collaborator of Dr. Brzustowicz from Canada. Dr. Brzustowicz brought the original invention disclosure to the Rutgers Technology Transfer Office on behalf of the co-inventors, who agreed to pursue patent protection for this invention.

The MPEP at §711.03(c) clearly indicates that, upon a petition under 37 CFR 1.137(b) and sufficient evidence, an unintentionally abandoned international application designating the U.S. should be revived. Clearly, the facts set forth above and the Declarations attached hereto provide every indication that the abandonment of the '013107 application was unintentional on behalf of Anne S. Bassett. As mentioned above, no assignment document was executed in this case, thus the present inventors clearly hold all rights in the present invention.

**APPLICANT'S RESPONSE TO DECISION ON PETITION UNDER 37
C.F.R. 1.137(b) DATED 2 OCTOBER 2006**

At page 2 of the Decision, the Attorney Advisor makes several statements that inaccurately reflect the Applicants' position in connection with efforts to revive this application. Notably, by January 2005, Linda Brzustowicz, a Rutgers co-

inventor became aware of the abandonment of the present application. The first Declaration by Drs. Brzustowicz and Bassett inadvertently indicated that Dr. Bassett was made aware of this abandonment as of that date. As clearly indicated in her second Declaration, Dr. Anne Bassett was not told the application was abandoned until November 2005 as stated in her Declaration filed on July 12, 2006.

Vincent Smeraglia had been informed by Dr. Brzustowicz that out of the 17 patent applications filed, this particular application contained information regarding a splice variant of the capon protein that appeared to be correlated with the schizophrenia phenotype. Accordingly, it was Dr. Brzustowicz's understanding that only this particular application would be pursued and the other related applications would be allowed to lapse. Thus, no efforts were made to revive the other applications. Clearly, the email from Vincent Smeraglia to Dr. Brzustowicz of January 2005, indicates that he believed that at least one application had been kept pending.

The undersigned agrees that as to Dr. Brzustowicz and Rutgers, the State University of New Jersey, the abandonment of the application does not appear to satisfy the criteria to demonstrate unintentional abandonment. However, the facts as they relate to Anne S. Bassett clearly indicate that as to her, this application was unintentionally abandoned. In contrast to the statement in the decision, next to the box where Anne S. Bassett's name appears on the PCT request form, the box indicating that she is Applicant and Inventor is checked. Thus, Dr. Bassett's standing as an Applicant cannot be challenged. She did not "give control of the prosecution" to Rutgers as stated in this decision. She was assured by Dr. Brzustowicz at the time the application was filed that all efforts would be taken to obtain patent protection for this invention. Dr.

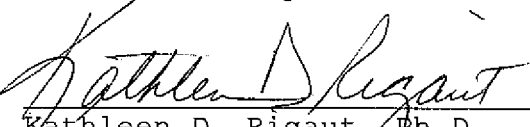
Bassett did not assign her rights in the invention to Rutgers, nor was she under an obligation to do so. Given the time period it takes for an application to be filed with the PCT followed by entry into the National phases, it was not unusual that years had passed with her hearing any progress on this application. She had no reason to believe that all efforts to keep this application in force would not be taken. As stated above, it was only in connection with a review of the facts surrounding this case that revealed Dr. Bassett's lack of awareness as to the status of the application. There was no legal agreement between Rutgers and Anne S. Basset, there was no relinquishment of her control of the application to Rutgers. Accordingly, Dr. Bassett still maintains that the entire delay in filing the national stage requirements under 35 U.S.C. 371(c) at the U.S. Patent and Trademark Office from the due date for the requirements under 35 U.S.C. 371(c) until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional.

Applicants again request the above-identified international application be revived. The necessary papers and fee for entering the US National Phase have been previously submitted.

Respectfully submitted,

DANN, DORFMAN, HERRELL AND SKILLMAN
A Professional Corporation

By


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Enclosures